REMARKS

Claims 1-32 were pending in the application prior to this amendment. Claims 1-32 were rejected. Claims 1, 2, 4, 6-8, 10, 12-15, 19, 21 and 23-32 have been amended. New claim 33 has been added. Applicant respectfully requests reconsideration and allowance of all pending claims.

Claim Rejections - 35 U.S.C. § 112

Claims 1-32 were rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement.

The test for enablement is whether the disclosure, when filed, "contained sufficient information *regarding the subject matter of the claims* as to enable one skilled in the pertinent art to make and use the *claimed invention*." *See* MPEP 2164.01 (emphasis added). Before enablement is considered, "it is necessary for the examiner to construe the claims", because it is the *subject matter of the claims* that is considered for enablement. *See* MPEP 2164.04 (emphasis added). In other words, an Examiner must identify features of the claims, not features of other parts of the application, as the basis for the enablement rejection.

Here, the Office Action indicates that the alleged basis for the enablement rejection is the "image correction" feature from the preamble. For example, the Office action states:

> Clearly, the specification would not enable one skilled in the art to make the claimed invention, which being the image correction by just extracting the plurality of bits and setting the MSB of the second correction signal to a value of 1 and saving these extracted bits. The specification does not teach how such extracting the plurality of bits and setting the MSB of the second correction signal to a value of 1 would provide image correction or would avoid LBB effect in the image. Clearly from the cited portions of the specification, after the bits are extracted and the MSB of the second correction digital signal is set to a value of 1, the data is stored in the memory and there is no information in the specification how this data is further used to correct the specified error such as LBB error. The description of the invention do not have any information on how setting of MSB of the second correction to 1 along with the few extracted bits would be used to correct the error since there is no processing of these bits after these bits are saved in the memory. There is no information in the specification how these bits along with the MSB are related to the LBB streaking effect and how these bits would be processed to show such an effect that will remove LBB errors. *See* the Office Action, page 7, last paragraph through page 8 first paragraph.

The Examiner may take the hindsight position that the claimed feature of "setting the most significant bit of the second correction digital signal to a value of one" is also the basis for the enablement rejection. However, this hindsight argument is unconvincing because the

Office Actions of record do not consider whether one would be capable of performing the process of "setting the most significant bit of the second correction digital signal to a value of one". Nor does any evidence of record indicate that one would be incapable of performing the process of "setting the most significant bit of the second correction digital signal to a value of one". Thus, the Office Action relies entirely on the preamble feature of "image correction" as an alleged basis *in the claims* for the enablement rejection.

Although the Office Action does not establish a prima facie case for rejecting the claims under enablement for at least the reasons explained in the amendment filed on February 9, 2007, in the interest of expediting prosecution, claim 1 has been amended to remove the image correction feature from the preamble. Claim 1, as amended, no longer recites "image correction".

Claim 1, as amended, recites a memory saving feature. The memory saving feature is supported by paragraph 10 of the present specification which states, "only the extracted last few bits of the first correction digital signal are stored in a memory such as a random access memory... so that the storage capacity requirement of the memory is reduced." *See* page 6, last sentence and page 7, first sentence (emphasis added).

Claim 1, as amended, includes novel and non-obvious features such as "wherein the extraction and storage of the last bits of the first correction digital signal and the first bits of the second correction digital signal reduces a memory requirement for scanning the correction documents". Claim 1 also includes other novel and non-obvious features such as "obtaining a second correction digital signal by scanning a second correction document during white correction, extracting only a plurality of first bits of the second correction digital signal, setting the most significant bit of the second correction digital signal to a value of one, and storing only the extracted first bits of the second correction digital signal in the same or a different memory". *See* page 4, first paragraph of the Office Action indicating that this feature is not disclosed in Ishizuka. Thus, claim 1 should be allowed.

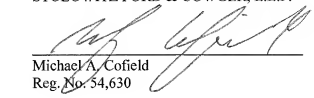
Independent claims 12, 23 and 28 as amended do not include the image correction feature and thus the enablement rejection should also be withdrawn for these claims and the claims should be allowed. New independent claim 33 has been added and should be allowed for at least similar reasons as explained with respect to claim 1. The dependent claims 2-11, 13-22, 24-27 and 29-32 include the features of their respective base claims and thus should be allowed for at least similar reasons.

Conclusion

For the foregoing reasons, reconsideration and allowance of all pending claims is requested. The Examiner is encouraged to telephone the undersigned at 503-224-2170 if it appears that an interview would be helpful in advancing the case.

Respectfully submitted,

STOLOWITZ FORD & COWGER, L.L.P.



Michael A. Cofield
Reg. No. 54,630

STOLOWITZ FORD COWGER LLP
621 SW Morrison Street, Suite 600
Portland, Oregon 97205

Customer No. 73552